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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, PHUOC H

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/635,736

Applicant(s)

ALLIBHOY ET AL.

Examiner

Phuoc H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 18-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-17 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17 drawn to a method for a user to interact with content providers coupled to a network, classified in **class 709, subclass 201**.
 - II. Claims 18-22, drawn to a method for generating revenues for a network offering programming option to a user via a receiver, classified in **class 705, subclass 61**.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions of Group I is related as combination and subcombinations of Group II.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombinations as claimed for patentability, and (2) that the subcombinations has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (Group I) as claimed does not require the particulars of the subcombinations (Group II) as claimed because to both subcombinations and combination are presented and assumed to be patentable, the omission of specific details of the subcombinations as recited in claims 18-22, in the combination as recited in claims 1-17 is evidence that the patentability of the combination does not rely on the details of the specific subcombinations. The subcombinations of Group II has separate utility such as generating revenues for a network offering programming option to a user via a receiver.
4. Inventions of the Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group II have separate utility such as

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generating revenues for a network offering programming option to a user via a receiver. See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and the search required a separate status in the art as shown by their different classification, the search required for one Group is not required for other Group, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. During a telephone conversation with Edwin Taylor (Reg. No. 25,129) on December 3, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-22 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-8, and 10-17 rejected under 35 U.S.C. 102(e) as being anticipated by

Blackketter et al. U.S. Patent 6,560,777.

11. Referring to claim 1, Blackketter reference disclose receiving a set of trigger filters (information sources) from the receiver, storing said set of trigger filters in a data base (col. 3, lines 1-41; and col. 7, lines 10-28); detecting triggers embedded in each of the plurality of enhanced content programming (video signals) (col. 6, lines 45-52); comparing said detected triggers with said set of trigger filters (col. 7, lines 35-47); identifying a set of the plurality of enhanced content programming (video signal) in which said detected triggers embedded in said set of enhanced content programming conform to said set of trigger filters, and preferentially coupling each of said set of enhanced content programming (video signal) to the receiver (Figure 3, and col. 7, lines 44-52).

12. Referring to claim 2, Blackketter reference disclose set of trigger filters is based on information type (sports, news, etc.) (col. 3, 1st paragraph; and col. 4, lines 50-58).

13. Referring to claim 3, Blackketter reference disclose transmitting a notification indicator for each occurrence in which said detected triggers embedded in said set of enhanced content programming conforms to said set of trigger filters (col. 2, 1st paragraph).

14. Referring to claims 4-5, Blackketter reference disclose notification indicator is an audible signal, and on-screen graphic (col. 2, 1st paragraph).

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15. Referring to claim 6, Blackketter reference disclose selecting said notification indicator, said selecting step performed by the receiver (col. 4, lines 3-19)

16. Referring to claim 7, Blackketter reference disclose preferential coupling step further comprising the steps of overriding current receiver programming and directing each of said set of enhanced content programming to the receiver immediately upon detection (col. 5, lines 29-47).

17. Referring to claim 8, Blackketter reference disclose receiving a set of priorities corresponding to each of said set of trigger filters, and storing said set of priorities in said data base, wherein said step of preferential coupling is performed in accordance with said set of priorities (col. 7, lines 29-60).

18. Referring to claim 10, Blackketter reference disclose storing a set of trigger identifiers in a data base (col. 3, lines 1-41; and col. 7, lines 10-28); detecting triggers embedded in the plurality of enhanced content programming (col. 6, lines 45-52); pairing said detected triggers with said set of trigger identifiers (col. 7, lines 35-47); and notifying the receiver of available enhanced content programming using said set of trigger identifiers (col. 2, 1st paragraph).

19. Referring to claim 11, Blackketter reference disclose set of trigger identifiers is comprised of a plurality of on-screen graphics (Figure 3).

20. Referring to claim 12, Blackketter reference disclose set of trigger identifiers is comprised of a plurality of audible signals (col. 2, 1st paragraph).

21. Referring to claim 13, Blackketter reference disclose step of receiving said set of trigger identifiers from the receiver (col. 3, lines 1-41; and col. 7, lines 10-28)

22. Referring to claim 14, Blackketter reference disclose the step of receiving said set of trigger identifiers from a network operator (broadcaster; Figure 3).

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23. Referring to claim 15, Blackketter reference disclose notifying step is performed upon initial receipt of the enhanced content programming (col. 2, 1st paragraph).

24. Referring to claim 16, Blackketter reference disclose set of trigger identifiers correspond to the plurality of content providers (Figures 3).

25. Referring to claim 17, Blackketter reference disclose set of trigger identifiers correspond to a plurality of information types (col. 4, lines 50-58).

Allowable Subject Matter

26. Claim 9 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Zigmond et al. U.S. Patent 6,571,392

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 703-305-5315. The examiner can normally be reached on Mon -Thu (7AM-4:30PM) and off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Phuoc H. Nguyen
Examiner
Art Unit 2143

December 3, 2003



DAVID WILEY
SUPERVISORY PATENT EXAMINER
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